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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,905	02/02/2001	Koichi Yoneta	58799-031	8110

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EXAMINER

ABDI, KAMBIZ

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/773,905	YONETA ET AL.	
	Examiner	Art Unit	
	Kambiz Abdi	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9/3/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The prior office actions are incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.

- Claims 1-4 and 7-18 are amended.
- No claim canceled.
- No claim added.
- Claims 1-18 have been considered.

2. Examiner withdraws objection to claim 2 due to correction by the applicant.

3. Examiner withdraws rejection of claims 1-2 and 11-18 under 35 U.S.C 112-second paragraphs due to corrections and amendments by the applicant.

Response to Arguments

4. Applicant's arguments filed 3 September 2004 have been fully considered but they are not persuasive for the following reasons:

In response to applicant argument regarding rejection of amended claims under 35 U.S.C. § 102 and 103 presented in that office action mailed on 4 June 2004.

5. The examiner believes that the argument that the applicant has put forward on regards to the amended claims is not persuasive on the characterizations of Downs and Ginter references, clearly they teach all the aspects of the claimed invention. Specifically, examiner disagrees with the applicant's arguments that there is no teaching of "storing a fee for using the digital information to a marketer area in a second storage medium that can not be accessed by the owner of that medium". It is clear by the teachings of Ginter as it has been clearly stated by the applicant that Ginter teaches secondary storage and recording information related to fee for charge (See page 14, lines 1-22). What applicant has failed to point out is that Ginter clearly teaches that the clearing house for collecting the fee and charges can be included within the VDE repository (See Ginter column 307, lines 57-68). Additionally Ginter is clear about the keeping credit or currency within the secure VDE that can be used as part of a fee payment (See Ginter column 316, lines 35-52). Regarding access control to the secure section related to the marketer

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(content creator, publisher, distributor, reseller, etc.) area would be an essential part of the system on the grounds that the repository owner has to be kept out of this area because of possible tampering with the data stored in this area.

6. Therefore, the examiner maintains the previous rejection and addition to the modifications made to the rejections of the claimed invention as they have been amended and presented in their current form.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3-10 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,226,618 to Edgar Downs in view of U.S. Patent No. 5,892,900 to Karl L. Ginter.

8. As per claims 1 and 2, Downs discloses a digital information sales method, comprising:

- storing to a first storage medium key data indicating permission to use the digital information (See Downs Figures 1D, 2, 3, 6, 10 and associated text along with column 23, lines 1-68); and
- storing to the first storage medium a program having a function for storing a fee for using the digital information to a marketer area in a second storage medium that cannot be accessed by the owner of the second storage medium when copying key data from the first storage medium to the second storage medium using the digital information controller (See Downs Figures 1D, 2, 3, 6, 10 and associated text along with column 23, lines 1-68, column 24, lines 1-68, column 25, lines 1-68, column 39, lines 25-68, column 40, lines 1-23, column 47, lines 26-68, and column 46, lines 1-26), and

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- a function for controlling the digital information controller to send fees stored in the marketer area to a marketer when communicating using the second storage medium (See Downs Figures 1D, 2, 3, 6, 10, and associated text along with column 23, lines 1-68, column 24, lines 1-68, column 25, lines 1-68, column 39, lines 25-68, column 40, lines 1-23, column 47, lines 26-68, and column 46, lines 1-26).

However, Ginter disclose storing a fee for using the digital information to a marketer area in a second storage medium that cannot be accessed by the owner of the second storage medium in a VDE for further processing as the digital content is utilized by the user (See Ginter figures 14A, 14C, and 25C and associated text, Column 17, lines 41-68, column 18, lines 1-38, column 23, lines 45-68, column 36, lines 27-43, column 63, lines 27-68, column 307, lines 56-68, column 312, lines 45-68, column 316, lines 35-53, and column 318, lines 38-58). Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the teachings of Downs and Ginter to achieve a more efficient and accurate accounting and better control over the usage of the traveling digital content rights in absence of communication with the central server.

9. As per claims 3 and 4, Downs discloses all the limitations of claims 1 and 2;

What Downs does not clearly disclose is storing a fee for using the digital information to a marketer area of one medium that cannot be accessed by the owner of the one storage medium when copying key data from storage medium N-1 (where N is an integer of 3 or more) to storage medium N. However, Ginter disclose storage of fees in a VDE for further processing as the digital content is utilized by the user (See Ginter figures 14A, 14C, and 25C and associated text, Column 17, lines 41-68, column 18, lines 1-38, column 23, lines 45-68, column 36, lines 27-43, column 63, lines 27-68, column 307, lines 56-68, column 312, lines 45-68, column 316, lines 35-53, and column 318, lines 38-58). Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the teachings of Downs and Ginter to achieve a more efficient and accurate accounting and better control over the usage of the traveling digital content rights.

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10. As per claims 5 and 6, Downs discloses all the limitations of claims 3 and 4;

What Downs does not clearly disclose is said program has a function for controlling so as to store said usage fee to said marketer area of storage medium N. However, Ginter disclose storage of fees in a secure section of the VDE for further processing as the digital content is utilized by the user (See Ginter Column 17, lines 41-68, column 18, lines 1-38, column 23, lines 45-68, column 36, lines 27-43, and column 63, lines 27-68). Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the teachings of Downs and Ginter to achieve a more efficient and accurate accounting and better control over the usage of the traveling digital content rights.

11. As per claims 7 and 8, Downs discloses all the limitations of claims 3 and 4;

What Downs does not clearly disclose is said program has a function for controlling so as to compare a user-marketer transaction count from storage medium N and from storage medium N-1, and storing said usage fee to the marketer area of the storage medium having the higher transaction count. However, Ginter disclose storage of fees in a secure section of the VDE for further processing as the digital content is utilized by the user (See Ginter Column 17, lines 41-68, column 18, lines 1-38, column 23, lines 45-68, column 36, lines 27-43, and column 63, lines 27-68). Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the teachings of Downs and Ginter to achieve a more efficient and accurate accounting and better control over the usage of the traveling digital content rights.

12. As per claims 9 and 10, Downs discloses all the limitations of claims 1 and 2;

What Downs does not clearly disclose is said program has a function for controlling an ATM terminal to send money information stored in the marketer area of the storage medium to the digital information sales apparatus when a storage medium having a usage/purchase amount stored in the marketer area is inserted to the ATM machine. The examiner takes Official Notice that making a payment of a usage/purchase amount via an ATM system is well established in the e-commerce industry.

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to utilize this method for optimizing the process of payment.

13. As per claims 11-16, A digital information sales method, apparatus, and medium comprising:

- storing to a first storage medium key data indicating permission to use the digital information (See Downs Figures 1D, 2, 3, 6, 10 and associated text along with column 23, lines 1-68); and
storing to the first storage medium a program having:
 - a function for controlling the digital information controller so that key data is copied in an unusable state when copying key data from the first storage medium to which the key data is written to a second storage medium using the digital information controller, and
 - a function for storing a fee for using the digital information to a marketer area of the second storage medium that cannot be accessed by the owner of the second storage medium.
 - a function for controlling the digital information controller to access the digital information marketer through a communications means when playing back the copied digital information to convert the key data stored to the second storage medium to a usable state (See Downs Figures 1D, 2, 3, 6, 10 and associated text along with column 23, lines 1-68, column 24, lines 1-68, column 25, lines 1-68, column 39, lines 25-68, column 40, lines 1-23, column 47, lines 26-68, and column 46, lines 1-26); and
 - a step for sending information for setting key data stored to the second storage medium to a usable state when access is made using the second storage medium containing unusable-state key data and the digital information usage fee is paid (See Downs Figures 1D, 2, 3, 6, 10 and associated text along with column 23, lines 1-68, column 24, lines 1-68, column 25, lines 1-68, column 39, lines 25-68, column 40, lines 1-23, column 47, lines 26-68, and column 46, lines 1-26).

However, Ginter disclose storing a fee for using the digital information to a marketer area (content creator, publisher, distributor, reseller, etc.) in a second storage medium that cannot be accessed by the owner of the second storage medium in a VDE and internal clearing house included within the VDE in the

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storage area, for further processing as the digital content is utilized by the user (See Ginter figures 14A, 14C, and 25C and associated text, Column 17, lines 41-68, column 18, lines 1-38, column 23, lines 45-68, column 36, lines 27-43, column 63, lines 27-68, column 307, lines 56-68, column 312, lines 45-68, column 316, lines 35-53, and column 318, lines 38-58). Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the teachings of Downs and Ginter to achieve a more efficient and accurate accounting and better control over the usage of the traveling digital content rights in absence of communication with the central server.

14. As per claims 17 and 18, Downs discloses all the limitations of claims 1 and 2;

What Downs does not clearly disclose is the first storage medium and the second storage medium each comprise an IC card containing electronic money information and key data unique to the IC card, and the key data indicating permission to use the digital information is encrypted using the key data unique to the IC card, when the key data indication permission to use the digital information is copied to the first storage medium or second storage medium. However, Ginter disclose the storage medium is an IC card and contains encryption data contained within (See Ginter figures 6-8, 14A, 14C, and 25C and associated text and column 40, lines 62-68, column 41, lines 1-68, column 42, lines 1-19 column 63, lines 27-68, column 307, lines 56-68, column 312, lines 45-68, column 316, lines 35-53, and column 318, lines 38-58). Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the teachings of Downs and Ginter for better security and portability of usage rights management tools and authorization.

15. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed

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invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Abdi whose telephone number is (703) 305-3364. The examiner can normally be reached on 9 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on (703) 305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

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**Commissioner of Patents and Trademarks
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or faxed to:

(703) 872-9306 [Official communications; including After Final communications labeled "Box AF"]

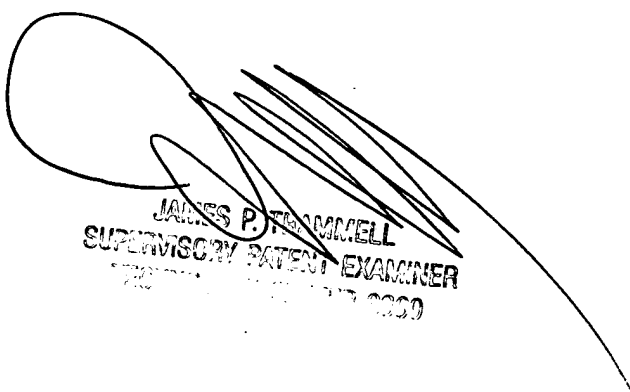
(703) 746-7749 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to:

**Crystal Park 5, 2451 Crystal Drive
7th floor receptionist, Arlington, VA, 22202**

Kambiz Abdi
Examiner

December 12, 2004



**JAMES P. TENNELL
SUPERVISORY PATENT EXAMINER
DECEMBER 12, 2004**